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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,656	12/17/2001	Amir Belson	BEL1020U	2664
25197	7590	03/22/2005	EXAMINER	
LEARY & ASSOCIATES 3900 NEWPARK MALL RD. THIRD FLOOR, SUITE 317 NEWARK, CA 94560			SULLIVAN, JULIANNE M	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No.	Applicant(s)	
	10/024,656	BELSON ET AL.	
	Examiner	Art Unit	
	Julianne M. Sullivan	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Boudreau et al. (WO 99/26411)</u> |

DETAILED ACTION

Response to Arguments

1. Applicants' arguments with respect to Claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.
2. With respect to Applicants' arguments regarding the rejection of Claims 1-3 as anticipated by Oz (U.S. Patent No. 5,079,629) and Claim 4 as unpatentable over Oz, the Examiner has relied upon the previously cited Meyers et al. (U.S. Patent No. 5,925,064) reference and has introduced a new reference, Taylor et al. (U.S. Patent No. 5,588,949), to meet the limitations added to the Claims. Meyers et al. expressly discloses a finger-mountable camera laterally offset from the user's hand, as discussed in the rejection below.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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4. Applicant is advised that should Claim 21 be found allowable, Claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 21, 22 and 24-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyers et al. (U.S. Patent No. 5,925,064).

Meyers et al. discloses a finger-mountable optical imaging system in the form of a miniaturized video camera that is laterally offset from the user's hand (as shown in Fig. 12), having smoothly tapered ends for ease of insertion, an illumination subsystem, a display monitor, a ring to attach the system to the user's hand, a fiber optic system and a wireless transmitter (col. 4, lines 14-18, col. 6, lines 32-41 and 55-57, col. 7, lines 21-23, col. 9, lines 57-65, col. 15, lines 35-58, Figs. 5-7 and ref. no. 61 in Fig. 12). Here, the Examiner has interpreted the disclosure in Meyers et al. of a low profile device as meeting Applicants' requirement of a device with tapered ends. As shown in Fig. 7, the Meyers et al. device is tapered at either end to conform to the curvature of the fingertip.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers et al. in view of Taylor et al. (U.S. Patent No. 5,588,949).

Meyers et al. discloses the claimed invention except for the limitation to a panoramic lens and an illumination subsystem having optical fibers arranged in a crescent pattern. In the same field of endeavor, Taylor et al. discloses an imaging system for minimally invasive surgery that provides a wide-angle lens for imaging of a large portion of the interior of the body cavity (col. 4, lines 59-61, col. 5, lines 4-6 and col. 11, lines 2-6). Taylor et al. further discloses an illumination system for illuminating the body cavity having a plurality of optical fibers in a crescent-shaped lumen (col. 9, lines 34-40 and 46-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the lens and illumination system of Taylor et al. in the camera system of Meyers et al. in order to have an improved view of more of the inside of the patient's body cavity.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boudreau et al. (WO 99/26411) discloses a related finger-mountable camera system that is laterally offset from the user's hand.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julianne M. Sullivan whose telephone number is 571-272-6084.

The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

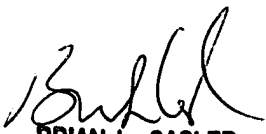

BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JMS



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